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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,512	06/23/2003	Thauming Kuo	71630	9715

7590 10/06/2006  
Michael K. Carrier  
Eastman Chemical Company  
P.O. Box 511  
Kingsport, TN 37662-5075

EXAMINER
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NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,512

Applicant(s)

KUO ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/30/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,12-15,17-22 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,12-15,17-22 and 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/30/06 has been entered.

The amendment of 8/30/06 has been entered. Claims 1-2, 4-9, 12-15, 17-22, and 25-33 are pending. Originally filed claim 24 provides support for "about" regarding the endpoint 8 of the claimed component a.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-9, 12-15, 17-22, and 25-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6262149 Clark et al..

Clark discloses the instantly claimed compositions and methods at the abstract; column 2, lines 35-67, particularly 54-67; column 3, lines 1-67, particularly 1-3 and 41-65; column 4, lines 1-67, particularly 25, 39, and 59; column 5, lines 1-67, particularly 1-19; column 6, lines 1-67, particularly 15-25; column 7, lines 1-67, particularly 1-27; column 8, lines 1-67, particularly 24-

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67; column 9, lines 1-67; column 10, lines 1-67, particularly 10-33 and 55-67; column 13, line 66 to column 14, lines 1-67, which falls within the scope of the reactant amounts of the instant claims 2 and 15; column 15, line 1-67; and the remainder of the document. The endpoint of column 3, line 2 falls within the scope of the instantly claimed particle size which anticipates the instantly claimed particle size. The applicant has not provided probative evidence that the particle size range of this section is not achievable where the amount of alkyd and acrylate of the instant claims and Clark are used and Clark does not exclude any particle sizes based on amounts of alkyd and acrylate. All things would not be expected to be equal per the applicant's argument because the particle size is determined by many more parameters than amount of alkyd including but not limited to molecular weights of polymers formed, amounts of hydrophilic moieties including acrylic acids etc., cosolvents used, emulsifiers, etc. This argument by the applicant is therefore not persuasive. The patentee is not limited to its examples. Arguments relating only to examples and ignoring the other teachings of the patent are therefore not persuasive.

Unexpected and surprising results do not overcome anticipation. The argued amount of alkyd and acrylate have endpoints falling within the scope of the instantly claimed ranges which anticipates these ranges. See MPEP 2131.03 II. One clearly envisions the endpoints of the prior art range and the instant prior art discloses ranges having an endpoint falling within the scope of the instantly claimed ranges which constitutes disclosing the instantly claimed invention with sufficient specificity.

Column 10, lines 10-33 encompass the instantly claimed amounts of component a and component b, particularly in view of the use of "about" in both the claims and the reference to define these terms. "About" regarding component a of the instant claims necessarily modifies

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the 92 of component b. Consideration of the endpoints of the sulfonated alkyd of the patentee of column 10, lines 27-28 shows the endpoint 5% which meets the instantly claimed amount of component a for reasons stated above. The next range is directed to acrylics, not all “ethylenically unsaturated monomers” of the instant claims. Note column 9, line 5, particularly “styrene” for an ethylenically unsaturated monomer which is not acrylic. Furthermore, “about” of column 10, lines 30-31 is taken as modifying 90 wt%, which is taken as encompassing 92 of the instantly claimed component b, which, as stated above, is necessarily modified by the “about” of component a, “about 8 weight percent”.

This rejection is therefore maintained.

5. Claims 1-2, 4-9, 12-15, 17-22, and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6262149 Clark et al..

Clark discloses the instantly claimed compositions and methods at the abstract; column 2, lines 35-67, particularly 54-67; column 3, lines 1-67, particularly 1-3 and 41-65; column 4, lines 1-67, particularly 25, 39, and 59; column 5, lines 1-67, particularly 1-19; column 6, lines 1-67, particularly 15-25; column 7, lines 1-67, particularly 1-27; column 8, lines 1-67, particularly 24-67; column 9, lines 1-67; column 10, lines 1-67, particularly 19-33 and 55-67; column 13, line 66 to column 14, lines 1-67, which falls within the scope of the reactant amounts of the instant claims 2 and 15; column 15, line 1-67; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art to use the instantly claimed combinations of ingredients and amounts thereof because they are encompassed by the patentee and would have been expected to give coatings having the properties described by the patentee.

The endpoint of column 3, line 2 falls within the scope of the instantly claimed particle size which anticipates the instantly claimed particle size. The argued amount of alkyd and acrylate have endpoints falling within the scope of the instantly claimed ranges which anticipates these ranges. See MPEP 2131.03 II. One clearly envisions the endpoints of the prior art range and the instant prior art discloses ranges having an endpoint falling within the scope of the instantly claimed ranges which constitutes disclosing the instantly claimed invention with sufficient specificity. The applicant has not demonstrated unexpected results nor surprising results in a manner commensurate in scope with the instant claims and the cited prior art. The applicant has not provided probative evidence that the particle size range of this section is not achievable where the amount of alkyd and acrylate of the instant claims and Clark are used and Clark does not exclude any particle sizes based on amounts of alkyd and acrylate. All things would not be expected to be equal per the applicant's argument because the particle size is determined by many more parameters than amount of alkyd including but not limited to molecular weights of polymers formed, amounts of hydrophilic moieties including acrylic acids etc., cosolvents used, emulsifiers, etc. This argument by the applicant is therefore not persuasive. The patentee is not limited to its examples. Arguments relating only to examples and ignoring the other teachings of the patent are therefore not persuasive.

Column 10, lines 10-33 encompass the instantly claimed amounts of component a and component b, particularly in view of the use of "about" in both the claims and the reference to define these terms. "About" regarding component a of the instant claims necessarily modifies the 92 of component b. Consideration of the endpoints of the sulfonated alkyd of the patentee of column 10, lines 27-28 shows the endpoint 5% which meets the instantly claimed amount of

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component a for reasons stated above. The next range is directed to acrylics, not all “ethylenically unsaturated monomers” of the instant claims. Note column 9, line 5, particularly “styrene” for an ethylenically unsaturated monomer which is not acrylic. Furthermore, “about” of column 10, lines 30-31 is taken as modifying 90 wt%, which is taken as encompassing 92 of the instantly claimed component b, which, as stated above, is necessarily modified by the “about” of component a, “about 8 weight percent”. It would have at least been obvious to one of ordinary skill in the art to use the instantly claimed amounts of a and b from the disclosure of the patentee because the choice of these amounts from the disclosure of the patentee, particularly considering the tolerances allowed by “about”, would have been expected to give the properties of the latex of the patentee. No unexpected results stemming from the instantly claimed amounts are seen in a manner commensurate in scope with the instant claims and the cited prior art.

This rejection is therefore maintained.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

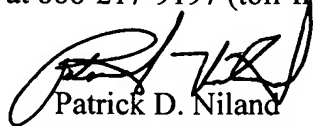
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland  
Primary Examiner  
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